

### REMARKS

Claims 4 and 7 are under consideration. Claims 4 and 7 have been amended. Claims 1, 2, 9-21, and 26-28 are withdrawn. Claims 3, 5, 6, 8 and 29-31 are currently cancelled.

The Applicant is amending to take the claims that the Examiner has found to be allowable. These are claims 4 and 7, which have been amended to include the features of former claim 3. The amendment places claims 4 and 7 in independent form, which page 4 of the Office Action says will be allowable in this condition. This type of amendment should be entered because it does not require further search or consideration.

#### **Claim Rejections under 35 U.S.C. § 112**

Claims 29, 30 and 31 stand rejected under 35 U.S.C. §112 second paragraph for recitation "structural analog thereof." The rejection is rendered moot by the cancellation of these claims; however, a structural analog is apparent to those skilled in the art and the term is not indefinite.

Claims 3-5, 8, 29-30 stand rejected under 35 U.S.C. §112 second paragraph. The rejection is rendered moot by cancellation of these claims, however, the Specification does enable the claims and undue experimentation is not required to practice what is claimed and the claims are not overly broad.

Claims 3-5, 8, and 29-31 stand rejected under 35 U.S.C. §112 first paragraph for written-description/possession. The cancellation of these claims renders the rejection moot; however, possession is demonstrated. To the extent that the Office views this as being a separate requirement from definiteness and enablement, the Office should clearly state the nature of the rejection in this manner and the particular language from 35 U.S.C.

§112 first paragraph that is relied upon. Applicant makes this request for particularity because the Office also does not rely upon authority to state the rules under which the "possession" standard is measured. *Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1320, 66 USPQ2d 1429, 1438-1439 (Fed. Cir. 2003) provides an explanation as to where these rules now stand:

The second application of the written description requirement is reflected in *Regents of the University of California v. Eli Lilly & Co.*, 119 F.3d 1559, 43 USPQ2d 1398 (Fed. Cir. 1997). There, this court invoked the written description requirement in a case without priority issues. Invoking §112, *Lilly* required a precise definition of a DNA sequence in the patent specification. In more recent cases, however, this court has distinguished *Lilly*. For instance, in *Enzo Biochem, Inc. v. Gen-Probe, Inc.*, 296 F.3d 1316, 63 USPQ2d 1609 (Fed. Cir. 2002), neither the specification nor the deposited biological material recited the precise "structure, formula, chemical name, or physical properties" required by *Lilly*. *Id.* at 1324 (quoting *Lilly*, 119 F.3d at 1566). Although this court initially determined that the specification in *Enzo* did not satisfy the *Lilly* disclosure rule, it revisited the issue and remanded to the district court. The court instructed:

On remand the court should determine whether a person of skill in the art would glean from the written description, including information obtainable from the deposits of the claimed sequences, subsequences, mutated variants and mixtures sufficient to demonstrate possession of the generic scope of the claims.

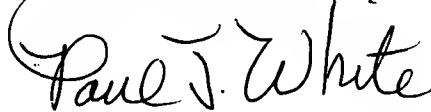
*Enzo*, 296 F.3d at 1328. Similarly, in this court's most recent pronouncement, it noted:

More recently, in *Enzo Biochem*, we clarified that *Eli Lilly* did not hold that all functional descriptions of genetic material necessarily fail as a matter of law to meet the written description requirement; rather, the requirement may be satisfied if in the knowledge of the art the disclosed function is sufficiently correlated to a particular, known structure. *Amgen*, 314 F.3d at 1332.

The Commissioner is authorized to charge any additionally required fees to deposit account 14-0460. Should the Examiner have any questions, comments, or suggestions that would expedite the prosecution of the present case to allowance,

Applicants' undersigned representative earnestly requests a telephone call at (303) 384-7575.

Respectfully submitted

A handwritten signature in cursive script that reads "Paul J. White". The signature is written in black ink and is positioned below the typed name.

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